UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2665	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 January 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14-32 and 34-105* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12, 14-32 and 34-105* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-12, 14-32 and 34-105 are rejected under 35 U.S.C. 102(e) as being anticipated

by Amir (USP 6711166).

Regarding claims 1, 16, 20, 36, 41, 51, 56, 66, 71, 76, 81, 87 and 89, Amir discloses (Figs

1-7 and col. 1, lines 10 to col. 13, lines 45) a system capable of performing state-based signaling

on behalf of a stateless client (Fig 2A, Ref 42A, 44A, Fig 6, Ref 26, ISDN and analog telephone

and IP terminal and Fig 7, Ref 122A, IP telephone), comprising a controller (Figs 2 and 6, Ref 94

which is embedded into the gateway, switch and router; See col. 1, lines 65-66), couplable to a

state-based terminal (Fig 2, Ref 48, Fig 6, Ref 26 and Fig 7, Ref 122B, H.323 terminal), that

translates at least one stateless signaling message received from said stateless client to at least

one state-based signaling message for presentation to said state-based terminal thereby

facilitating a media stream communications session between said stateless client and said state-

based terminal using an Internet Protocol (IP)-based network, wherein the media stream

communications session is comprised of packets exchanged between said stateless client and said

state-based terminal (Figs 2, 6-7, packet network such internet or intranet; See col. 3, lines 60 to

col. 4, lines 60, col. 5, lines 49 to col. 8, lines 54 and col. 9, lines 29 to col. 11, lines 3 and col.

11, lines 66 to col. 12, lines 8 for exchanging the signaling packet for establishing

communication path between the state less and state base client in order to convey the media

packet).

Regarding claims 2, 17, 22, 37, 42, 52, 57 and 67, Amir discloses controller translates at

least one state-based/stateless signaling message received from said state-based/stateless terminal

to at least one stateless/state base signaling message for presentation to said stateless/state base

client (Figs 2 and 6, Ref 94).

Regarding claims 3, 23, 43, 58, 72, 77, 82, 88, 90, 93 and 101-102, Amir inherently

discloses controller comprises a protocol engine and a stateless client control engine (Figs 2 and

6, Ref 94).

Regarding claims 44, 59, 73 and 78, Amir discloses controller comprises a call manager

messaging and a stateless client message interface (Fig 2, Ref 94).

Regarding claims 74 and 79, Amir discloses a gateway coupling between intranet and

Internet (Fig 2, Ref 40A)

Regarding claims 4, 18, 24, 38, 45, 53, 60 and 68, Amir discloses controller forms an

abstraction of said at least one stateless signaling message prior to translating (Fig 4).

Regarding claims 5, 19, 25, 39, 46, 54, 61, 69 and 84, Amir discloses system performs

state-based signaling on behalf of a plurality of stateless clients (Fig 4).

Regarding claims 47, 55, 62, 70, 85, 86, 92 and 100, Amir discloses network employs a

transport protocol selected from the group consisting of an Internet Protocol (IP), an Internet

work Packet Exchange / Sequenced Packet Exchange (IPX/SPX), and a Systems Network

Architecture (SNA) (Fig 7).

Regarding claims 6, 20, 26 and 40, Amir discloses media stream includes portions selected from the group consisting of voice, video, and data (Col. 2, lines 3-9).

Regarding claims 7, 27, 48 and 63, Amir discloses portions of said media stream traverse a path between said stateless client and said state-based terminal without said controller (Fig 2B, Ref 90 or Fig 2A, LAN/IP network).

Regarding claims 8, 28, 49, 64 and 83, Amir discloses at least one state-based signaling message and said at least one stateless signaling message traverse a signaling path separate from a path for said media stream (Figs 2A and 6A, Ref ISDN, Analog).

Regarding claims 9 and 29, Amir discloses portions of said media stream traverse a path between said stateless client and said state-based terminal with said controller (Fig 6A, Ref 94).

Regarding claims 10, 30 and 96, Amir discloses said at least one state-based signaling message is based on a protocol selected from the group consisting of H.225, H.235, H.245, and H.323 (Col. 6, lines 1-17, H.323, H.245, encryption H.235 and H.225, RAS inherently).

Regarding claims 11 and 31, Amir discloses stateless client is selected from the group consisting of a device having an individual telephone, at least one digital trunk interface, at least one analog trunk interface, at least one digital station interface, at least one analog station interface, and a shared system resource (Figs 2, 6 and 7).

Regarding claims 12 and 32, Amir inherently discloses at least one stateless signaling message includes an indication selected from the group consisting of a telephony "off-hook" event, a telephony "on-hook" event, a telephony "button depressed" event, a telephony "digit dialed" event, and a "client registration" event (Fig 2A and Figs 6-7, telephone devices generates a signaling message which comprises on/off hook, dialed digit etc).

Regarding claims 14 and 34, Amir discloses controller operates only with respect to call

management and management of said media stream (Fig 2, Ref 28 and 94).

Regarding claims 15, 35, 50, 65, 75 and 80, Amir discloses system is embodied as a

sequence of instructions executable in a general purpose computer system (Col. 13, lines 5-17).

Regarding claims 91, 97-99 and 103-104, Amir discloses(Figs 1-7 and col. 1, lines 10 to

col. 13, lines 45)a method for establishing a communications session with a remote state-based

terminal (Fig 2B, Ref 48B is H.323 for translating voice packet into analog voice to present to

the stateless user), the method comprising the following steps performed at a stateless client (Fig

2A, Ref 42A and Fig 7, Ref 112A, IP telephone for translating voice packet into analog voice to

present to the stateless user); receiving a call initiation signaling message generated at a remote

state-based terminal and translated into a stateless call initiation signaling message for

presentation to the stateless client to establish a communications session between the stateless

client and the remote state-based terminal; processing the stateless call initiation signaling

message to determine that the stateless client is able to conduct the communications session

initiated at the remote state-based terminal; communicating a stateless acknowledgement

signaling message for translation and delivery to the remote state-based terminal as a state-based

acknowledgement signaling message; and exchanging packets with the remote state-based

terminal using a packet network (Fig 2, Ref 94 for converting the signaling message between the

telephone and terminal and determining if a call can be established, send acknowledge message,

See col. 3, lines 60 to col. 4, lines 60, col. 5, lines 49 to col. 8, lines 67 and col. 9, lines 1 to col.

11, lines 3 and col. 11, lines 66 to col. 12, lines 8 for exchanging the signaling packet for

· establishing communication path between the state less and state base client in order to convey

the media packet).

Regarding claims 94 and 105, Amir inherently discloses a ring on, off hook message.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5.   Claims 1-12, 14-32 and 34-105 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kubler et al (USP 5,726,984) in view of Amir (USP 6711166).

Kubler teaches a system capable of performing state-based signaling on behalf of a

stateless-client (6331) comprising a controller (6333) coupled to a state-based terminal (6301,

6303), that translates at least one stateless signaling message (telephony dialing) received from

the stateless client (6331) to at least one state-based signaling message for presentation to said

state-based terminal (6301, 6303) thereby facilitating a media stream communications session

between said stateless client (6331) and said state-based terminal (6301, 6303) over an IP-based

network (6315). Kubler differs from the claims in that Kubler does not teach that the stateless

client (6331) communicates with the state-based client (6301, 6303) using packets. However,

Amir discloses (Figs 1-7 and col. 1, lines 10 to col. 13, lines 45) a system for exchanging

multimedia packet between the stateless and state-based device (Fig 7 wherein the H.323

terminal "state-based" and IP telephone "stateless"). Thus, it would have been obvious to one

skilled in the art at the time the invention was made to apply the teaching of the telephone

(stateless client) communicating with a computer (state-based client) using packets as disclosed

by Amir into Kubler's telephone 6331 with the motivation being to enable the user of the

telephone to handle both regular telephone call and reduce the long distance cost .

Response to Arguments

6.   Applicant's arguments filed 1/12/05 have been fully considered but they are not

persuasive.

        In response to pages 24-25, the applicant states that Amir fails to disclose facilitating a

media stream communications session between the stateless client and the state-based terminal

using IP network, wherein the media stream communications session is comprised of packets

exchanged between the stateless client and the state-based terminal. In reply, Amir clearly

discloses the stateless device "Fig 6A, Ref 26s, IP terminal as set forth at Sec. 2 and 5" and state-

based terminal "Fig 6B, Ref 26, H.323 Terminal as set forth at Sec. 2 and 5" exchanges the

media stream communication session being comprised of the packets via internet network 24 of

Fig 6B. Futhermore, Amir disclose a stateless device "Fig 7, Ref 122A, IP telephone as set forth at Sec. 2 and 5" and state-based terminal "Fig 7, Ref 122B-C as set forth at Sec. 2 and 5" exchange the media stream communication session being comprised of the packets via internet network packet network.

In response to pages 25-27, the applicant states that Amir fails to disclose facilitating a media stream communications session between the stateless client and the state-based terminal using IP network, wherein the media stream communications session is comprised of packets exchanged between the stateless client and the state-based terminal. In reply, Amir clearly discloses the stateless device "Fig 6A, Ref 26, IP terminal as set forth at Sec. 2 and 5" and state-based terminal "Fig 6B, Ref 26, H.323 Terminal as set forth at Sec. 2 and 5" exchanges the media stream communication session being comprised of the packets via internet network 24 of Fig 6B. Futhermore, Amir disclose a stateless device "Fig 7, Ref 122A, IP telephone as set forth at Sec. 2 and 5" and state-based terminal "Fig 7, Ref 122B-C as set forth at Sec. 2 and 5" exchange the media stream communication session being comprised of the packets via internet network packet network.

7.   In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art and/or the nature of the problem to be solved. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) and In re rouffet, 149 F 3.d 1350, 47 U.S.P.Q.2d

1453 (Fed Cir. 1998). In this case, Kubler discloses a method and system for exchanging a

media between the stateless and state-based client via internet network. Amir discloses a method

and system for exchanging media communications session between the stateless and state-based

client via internet network wherein the media communication session comprises packets for

exchanging between them. Therefore, it would have been obvious to one of ordinary skill in the

art at the time of invention was made to integrate a stateless and state-based device into IP

network for exchanging the information comprising the packets between the stateless and state-

based client as disclosed by Amir's system and method into the system and method of Kubler.

The motivation would have been to reduce the cost of telephone call.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
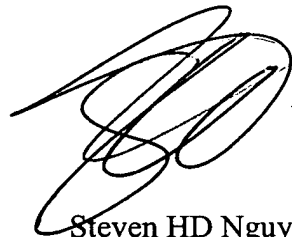
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven HD Nguyen
Primary Examiner
Art Unit 2665
5/15/05